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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,161	11/14/2003	Mark Carlton	674580-2004	2908

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EXAMINER

LI, RUIXIANG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/714,161	CARLTON ET AL.	
	Examiner	Art Unit	
	Ruixiang Li	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicants' election with traverse of Group IV, Claim 10, a method for identifying an antagonist of a Mowgli GPCR, classified in class 435, subclass 5 in the reply filed on 06/26/2006 is acknowledged.
2. Applicants' amendment filed on 06/26/2006 has been entered in full. Claims 1-12 have been canceled, claims 13-27 have been added. Claims 13-27 are pending.
3. The newly added claims 13-27 are further restricted to one of the following inventions as required under 35 U.S.C. 121:
 - I. Claims 13-18, 26, and 27, drawn to a method of identifying a molecule suitable for the treatment or alleviation of pain, comprising contacting a candidate molecule with a Mowgli GPCR polypeptide and determining if the candidate molecule is an agonist or antagonist, classified in class 435, subclass 4.
 - II. Claims 19-23, drawn to a method of identifying an agonist or antagonist of a Mowgli GPCR polypeptide, comprising administering a candidate molecule to an animal and determining whether the animal exhibits an increase in sensitivity to pain, classified in class 514, subclass 1.
 - III. Claim 24 (in part), drawn to a method for providing an indication useful in the diagnosis of or determination of susceptibility to pain in an individual, comprising detecting a change in the expression pattern of of a Mowgli polypeptide, classified in class 435, subclass 7.1.

IV. Claim 24 (in part), drawn to a method for providing an indication useful in the diagnosis of or determination of susceptibility to pain in an individual, comprising detecting a change in the level of a Mowgli polypeptide, classified in class 436, subclass 501.

V. Claim 25, drawn to a method for providing an indication useful in the diagnosis of or determination of susceptibility to pain in an individual, comprising detecting a polymorphism in a Mowgli polynucleotide, classified in class 435, subclass 6.

4. The inventions are distinct, each from the other for the following reasons. Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §806.04, MPEP §808.01). In the instant case, the different inventions are drawn to completely different methods. Invention I requires contacting a candidate molecule with a Mowgli GPCR polypeptide and determining if the candidate molecule is an agonist or antagonist; Invention II requires administering a candidate molecule to an animal and determining whether the animal exhibits an increase in sensitivity to pain; Invention III requires diagnosis of or determination of susceptibility to pain in an individual, comprising detecting a change in the expression pattern of a Mowgli polypeptide; Invention IV requires diagnosis of or determination of susceptibility to pain in an individual, comprising detecting a change in the level of a Mowgli polypeptide; whereas Invention V requires diagnosis of or determination of susceptibility to pain in an individual, comprising detecting a polymorphism in a Mowgli polynucleotide.

Art Unit: 1646

These methods are not interchangeable and require non-cohesive searches and considerations.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. Because these inventions are distinct for the reasons given above and the search required for a single group is not required for any other group, restriction for examination purposes as indicated is proper.
7. Furthermore, the application contains numerous nucleic/amino acid sequences represented by different SEQ ID NO. Each individual sequence represents a structural and functionally distinct entity that is capable of supporting a separate patent. The search and consideration of more than a single sequence constitutes an undue search burden on the office, given the ever-increasing size of the database.

The Examiner notes that this is not a species election requirement; rather it sets forth additional invention groups. Applicant is advised that a reply to this requirement must include an identification of an amino acid or nucleic acid sequence that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election..


Art Unit: 1646

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (I).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on (571) 272-0835. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.


Ruixiang Li, Ph.D.
Primary Examiner
September 14, 2006

RUIXIANG LI, PH.D.
PRIMARY EXAMINER